REMARKS

STATUS OF THE CLAIMS

Claims 1, 3, and 5-18 are pending in the application.

Claims 1, 3, 5-7, 9, 12, 14, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Deo et al. (U.S. 5,721,781).

Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by LeBourgeois (U.S. 6,026,166).

Claims 8, 10, 11, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deo et al. (U.S. 5,721,781) in view of LeBourgeois (U.S. 6,026,166).

According to the foregoing the claims are amended, and, thus, claims 1, 3, and 5-18 remain pending for reconsideration, which is respectfully requested.

No new matter has been added.

REJECTION

The Office Action maintains from the previous Office Action the rejections. Office Action page 5, item 8 is the Response to Arguments, in which the Examiner asserts that previous amended claims and arguments have not been persuasive. It is believed the Office Action did not consider the claim language of independent claims 1, 13, 14, 17, and 18 and the Office Action did not answer the substance of the previous arguments according to USPTO guidelines, so finality of the Office Action appears to be premature and withdrawal of the same is respectfully requested.

The Office Action rejection rationale is traversed, as follows:

The independent claims are 1, 13, 14, 17 and 18. First, the independent claims 1, 14, 17 and 18 are amended for clarity. Second, independent claim 13 is amended to further emphasize a patentably distinguishing feature of the claimed present invention. Third, independent claim 18 is amended to be a computer readable medium type claim directed to a server along the lines of independent claim 13.

Deo discusses "during a transactional session, the smart card and terminal exchange their certificates to authenticate one another. Thereafter, a smart card application is selected

and the related certificates for both the smart card application and the terminal application are exchanged between the smart card and terminal to authenticate the applications. Additionally, the cardholder enters a unique PIN into the terminal." It is readily apparent Deo differs from the claimed present invention, because Deo fails to disclose or suggest (is silent on) the claimed present invention's, "***selecting*** one of the plural ***identification conditions*** ***to perform identification***, according to~~in accordance with~~ ***identification condition setting information*** ~~that is~~ ***received from a server every time*** ~~***when receiving***~~ ***a request for identification*** ***is received*** ***from the server***," and "***sending to the server, as a confirmation, identification condition used*** ~~condition information that indicates one of the identification conditions, which was used~~ ***by the personal identification terminal for the identification***, in a format enabling detection of an alteration thereof, together with a result of the identification."

Regarding the anticipatory rejection of claims 1, 3, 5-7, 9, 12, 14, 17 and 18 over Deo, the claimed present invention's "***identification condition setting information***" to set an identification condition (identification means/level) to be used for identification is sent to a terminal from a server together with a request for identification. Then, after the identification is performed by the terminal, "***identification condition used***" by the terminal, which indicates the identification condition that was used for the identification, is sent to the server together with a result of the identification. This provides a benefit of allowing the server to confirm whether the identification was properly performed in the terminal by using the identification condition set or specified by the server. Nothing in Deo, however, mentions about means or methods for a terminal to inform the server of the identification condition really used by the terminal.

In addition, according to the claimed present invention as recited in independent claim 1, "***identification condition setting information***" sent or transmitted by a server to a terminal includes a digital signature for detecting an alteration thereof.

The Examiner alleges in the previous Office Action page 3, regarding claim 2, "the smart card and the terminal transmit back and forth various information which includes a digital signature." It seems correct in itself. However, the digital signature in Deo is used for performing the identification securely on the terminal side when performing the identification, and it is not used between the terminal and the server as used according to the claimed present invention. In other words, according to the claimed present invention, the digital signature is not used when the terminal performs the identification, but used when information for setting or

specifying the identification condition ("***identification condition setting information***") is sent from the server ahead of or prior to the identification by the terminal, and used when information about actual identification condition used by the terminal ("***identification condition used by the ... terminal for the identification***") is sent from the terminal to the server after the terminal performs the identification, for detecting alternation of these two pieces of information (see, for example, dependent claim 7). Transmitting and receiving the digital signature between the smart card and the terminal in Deo does not correspond to the claimed present invention.

The previous Amendment clearly focused on these patentably distinguishing features in page 8, item 2, however, the Office Action does not appear to address the same.

The Office Action provides in page 5, item 8, "Examiner notes that Applicant amended claim 1 incorporating the subject matter recited in claims 2 and 4. However, in the previous Office Action, claims 2 and 4 were anticipated by the Deo patent." However, in the previous Office Action, page 3, item 4, for example, regarding claims 1, 2 and 4, it is readily apparent that the rationale fails to take into consideration any of the claim language of the present invention. For example, the expressions "***selecting*** one of the plural ***identification conditions to perform identification***, according to ~~in accordance with~~ ***identification condition setting information*** ~~that is~~ ***received from a server every time*** ~~***when receiving***~~ ***a request for identification is received from the server***," and "***sending to the server, as a confirmation, identification condition used*** ~~condition information that indicates one of the identification conditions, which was used~~ ***by the personal identification terminal for the identification***," do not appear anywhere in page 3 of the previous Office Action or in the present final Office Action.

The previous Office Action in page 3, lines 15-16 provided, "Since security level is determined by the amount of transaction, the lowest level security can be considered a default level." Deo discusses selecting a target application (e.g., Abstract, column 5, lines 32-34), but Deo fails to disclose or suggest the claimed present invention's "***selecting*** one of the plural ***identification conditions to perform identification***, according to ~~in accordance with~~ ***identification condition setting information*** ~~that is~~ ***received from a server every time*** ~~***when receiving***~~ ***a request for identification is received from the server***," because Deo does not send "identification condition ***setting*** information."

Deo in column 10, line 40 to column 11, line 25, discusses configuring the system to "accommodate different security levels." Deo discusses, the "type of terminal is added as part of the identity information contained in the terminal-related certificate. Different security levels are established based upon these terminal types" (column 10, lines 56-59). However, in contrast to Deo's security level establishment based upon a terminal type in the terminal-related certificate, in the claimed present invention a personal identification terminal receives from the server "***identification condition setting***" based upon which to perform an identification matching process or "***identification.***" For example, according to the present invention, "***identification condition setting***" can be setting from a server to instruct an information terminal to use a password and biological information for identification. Once the information terminal uses a password and biological information for identification, the information terminal sends to the server what identification condition was used, in this case a password and biological information, and sends to the server the result of the identification (i.e., "***sending to the server, as a confirmation, identification condition used*** ~~condition information that indicates one of the identification conditions, which was used~~ ***by the personal identification terminal for the identification***, in a ***format*** enabling ***detection of an alteration*** thereof, together with ***a result of the identification***").

Regarding the Office Action assertion in page 5, item 8, that "in previous Office Action, claims 2 and 4 were anticipated by the Deo patent," the Applicants note that the previous Office Action, page 3, Re claim 2, provided, "the smart card and the terminal transmit back and forth various information which includes a digital signature (see abstract)." However, it is clearly apparent that claimed present invention does not simply recite transmitting back and forth a digital signature. Claim 1 of the present invention recites:

> ... ***selecting*** one of the plural ***identification conditions to perform identification***, according to~~in accordance with~~ ***identification condition setting information*** ~~that is received~~ ***from a server every time*** ~~***when receiving a request for***~~ ***identification is received from the server***, wherein the ***identification condition setting information*** received from the server ***includes a digital signature for detecting an alteration thereof ...***

Deo does not discuss, "***identification condition setting information ... includes a digital signature for detecting an alteration thereof.***" or in other words, Deo does not discuss

any type of "***identification condition setting information*** ~~that is~~ ***received from a server every time*** ~~***when receiving a***~~ ***request for identification*** ***is received from the server***" and "***selecting*** one of the plural ***identification conditions*** ***to perform identification***, according ~~to~~***in*** ~~accordance with~~ ***identification condition setting information*** ~~that is~~ ***received from a server.***"

The previous Office Action, page 3, lines 13-15, provides that Deo's "ATM machine can certainly interpreted as a server." However, Deo's ATM machine does not receive any "***identification condition setting information***" from a server to instruct the ATM machine to perform identification with the smart card according to the setting information. In Deo, the ATM machine's certificate would contain a terminal type data based upon which the smart card does an appropriate security level transaction. FIG. 3 of the present Application provides a smart card 1a, an information terminal 1b and a server 2. Deo, fails to disclose or suggest the server 2 sending "***identification condition setting information,***" to the information terminal 1b.

Further, Deo's "type of terminal (from the terminal-related certificate)" (column 11, lines 20-21) differs from the claimed present invention's, "***identification condition setting information*** ~~that is~~ ***received from a server every time*** ~~***when receiving a***~~ ***request for identification*** ***is received from the server,***" because a benefit of the "***identification condition setting***" is to change or update the setting according to application criteria by the server 2 of the present invention. Deo's "type of terminal ... added ... in the terminal-related certificate" (column 10, lines 56-57) would be fixed and not settable by the terminal 32 of the Deo.

Similarly, the previous Office Action, page 3, Re claim 4, provides, "when the incorrect PIN is entered, the incorrect PIN is an "altered identification information," resulting in that authentication has failed." However, it is clearly apparent that claim 1 of the present invention recites:

> ... ***sending to the server, as a confirmation, identification condition used*** ~~condition information that indicates one of the identification conditions, which was used~~ ***by the personal identification terminal for the identification***, in a ***format*** enabling ***detection of an alteration*** thereof, together with ***a result of the identification***.

In other words, while Deo discusses detecting an incorrect PIN, Deo is silent on the claimed expression, "***sending to the server, as a confirmation, identification condition used*** ~~condition information that indicates one of the identification conditions, which was used~~ ***by the***

personal identification terminal for the identification, in a ***format*** enabling ***detection of an alteration*** thereof, together with ***a result of the identification.***" First, Deo does not send "***identification condition*** ***used*** ~~condition information that indicates one of the identification conditions, which was used~~ ***by the personal identification terminal for the identification,***" because used condition information is what condition information was used to perform identification, which differs from a PIN. In other words, Deo does not send to its terminal information that the smart card used a PIN to authenticate the user of the smart card. Second, Deo dos not send a PIN in a format to detect an alteration thereof, because a PIN is compared against existing data to determine entry of a correct PIN and not that the PIN was altered. Third, Deo does not send "***identification condition*** ***used*** ~~condition information that indicates one of the identification conditions, which was used~~ ***by the personal identification terminal for the identification ... together with result of identification.***"

A benefit of the claimed present invention is that the server can confirm that identification was performed according to the sent "***identification condition information setting.***" Deo's terminal cannot not confirm that the smart card performed a transaction according to the appropriate security level of the terminal. See, page 10, line 22 to page 11, line 8; and page 17, of the present application.

Accordingly, the previous Office Action rationale was clearly traversed in the previous Amendment, thus, requiring the Office Action to expressly address the substance of the Applicant's arguments. MPEP 707.07(f) provides, "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." According to 37 CFR 1.104(b), the Examiner's answer must be complete as to all matters. For example, although the Office Action provides in page 5, last paragraph, that the "amended claims and remarks describing these elements have been fully considered, but they are not persuasive, and therefore, the Examiner has made this Office Action final," contrary to MPEP 707.07(f) -Answer All Material Traversed - there is no clear explanation anywhere in the previous office action or in the present Office Action that the Examiner has considered in view of Deo, for example, the claim recitations, "***selecting*** one of the plural ***identification conditions to perform identification***, according to~~in accordance with~~ ***identification condition setting information*** ~~that is~~ ***received from a server every time*** ~~***when receiving a***~~ ***request for identification is received from the server,***" as generally recited in the

original independent claims and not as subject matter incorporated from dependent claims 2 or 4. Further, the final Office Action does not address the arguments presented in the previous Amendment, as though the claims can be finally rejected because they are clearly open to rejection, which is clearly not the case.

The finality of the Office Action should be withdrawn to apply a new ground of rejection, because clearly in view of the remarks herein Deo fails to disclose or suggest, either expressly or inherently, every element of the claimed present invention and cannot anticipate the claimed present invention. See MPEP 706.07(c), 706.07(d) and MPEP 706.07(e). See MPEP 706.07(a) - The finality of the Office Action is premature, because no new ground of rejection has been provided in the Office Action and further the claims cannot be finally rejected if they are not clearly open to rejection on grounds of record, because according MPEP 2131, "TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP Section 2131.01."

INDEPENDENT CLAIM 13

Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by LeBourgeois (U.S. 6,026,166).

According to the clamed present invention as recited in independent claim 13, Information of the result of the identification and a score, which is a similarity of biometric identification, is sent from the terminal to the server, if biometric identification is performed by the terminal (i.e., in contrast to LeBourgeois, the claimed present invention provides, "storing a log of ***a score that indicates a similarity, if the personal identification terminal performed the identification using biometric information,*** or a hash value of the score, that was ***added to result information of ~~a result of identification,~~ the identification received from the***

personal identification terminal ***according to the sending of the identification condition setting information,*** ~~received from the personal identification terminal~~"). Then, the server can decide whether the identification failed when, for example, the same score value continues several times despite the result of the identification. On the other hand, in LeBourgeois, the certification result is negative, if the number of reauthorizations is large, which differs from the claimed present invention's, "~~deciding that identification is failed when the~~***failing the identification, if same score value continues several times in accordance with the read log of the score*** or the hash value of the score, ***despite the*** ~~a~~ ***result of the identification received from the personal identification terminal.***" The above-explained claimed present invention is not, however, mentioned in the LeBourgeois. LeBourgeois cannot anticipate the claimed present invention as recited in independent claim 13, because LeBourgeois fails to disclose or suggest, either expressly or inherently, every element recited in claim 13.

CONCLUSION

A benefit of the claimed present invention as recited in pending claims 1, 3 and 5-18 is identification is surely performed by using specified identification condition due to the above-mentioned characteristic structures that are not mentioned in the relied upon references, which can produce an effect of preventing fraudulent usage and improving security.

Dependent claims recite patentably distinguishing features of their own and/or are patentably distinguishing due to their dependencies from the independent claims.

In view of the remarks herein, withdrawal of the rejection of pending claims and allowance of pending claims is respectfully requested.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Respectfully submitted,
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